

REMARKS

Reconsideration of this application is respectfully requested.

Initially, Applicant would like to thank the Examiner for indicating the allowability of claims 6, 8-18, 22-24, 28, 29, 32-37, 39, 44 and 47 if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

In the Office Action, the Examiner rejects claims 1-5, 7, 19-21, 25-27, 30-31, 38, 40-43, 45-46 and 48 under 35 U.S.C. §103(a) as being allegedly unpatentable over Admitted Prior Art in view of U.S. Patent No. 5,060,296 to Grube et al. (hereinafter "Grube"). In response, Applicant respectfully traverses the Examiner's rejection for at least the reasons as set forth below.

Specifically, in regard to independent claims 1, 25, 26 and 45, the Examiner alleges that the Admitted Prior Art, on page 1, lines 1-19, teaches a base station, a mobile station communicable with the base station through a radio channel and an object device controllable by the radio channel. Further, the Examiner alleges that Grube teaches a monitoring unit for monitoring the status of the object device to produce a status signal, and a control unit coupled to the monitoring unit for responding to the base station through the radio channel on the basis of the status signal. Therefore, the Examiner alleges that the combination of the prior art with Grube renders the present invention obvious.

The present invention provides for a monitoring unit that monitors a status of an object device to produce a status signal representative of the status of the object device, such as whether the object device is in an active state, whether the object device is communicable with the mobile station, and/or whether the object device is connected to the mobile station. Further, a control unit is coupled to the monitoring unit for responding to the base station through a radio channel

on the basis of the status signal when the base station calls the mobile station. Thus, the present invention lets the user respond to an incoming call without checking the status of the object device, regardless of the status of the object device.

Grube, on the other hand, as seen in Fig. 1 and recited in Col. 2, line 34 – Col. 3, line 16, teaches two communication units 103 that communicate with each other through repeaters 102. Communication unit 1 sends a message A to repeater 2, and repeater 2 retransmits that signal as signal B to communication unit 2. The message A is a talk request, and the resource controller transmits a signal B such as an acknowledgment signal that is a channel assignment grant in response to the talk request. Thus, Grube simply teaches allowing two communication units to communicate with each other, such as allowing two users with communication units 103 to talk to each other.

The present invention, on the other hand, teaches a mobile station that monitors a status of an object device and produces a status signal. It is not related to two mobile stations communicating with each other, such as Grube. Further, the present invention teaches a control unit that responds to a base station on the basis of the status signal when the base station calls the mobile station. Thus, the base station is informed of the status of the object device when the base station calls the mobile station. Grube does not teach reporting a status of an object device to a base station when the base station calls a mobile station. Grube instead teaches a mobile station calling another mobile station through a resource controller, which simply grants a talk request and allows the two communication units to talk to each other. This is completely different than what is recited in the claims of the present invention.

Further, the present invention relates to a communication system comprised of a mobile terminal, such as a cellular phone, and an object or image device, such as a video terminal

device, a digital camera, a digital video camera or a VCR. Both the mobile terminal and the image device are used by the same user and used independently of each other. Thus, there is no need to transmit an image to any other device from the image device. Therefore, the communication between the mobile terminal and the image device is novel in comparison with the cited references cited in the Background of the Invention (Admitted Prior Art). Further, Grube is directed to a communication system comprised of repeaters and a communication unit that is completely different from that of the present invention.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Grube fails to teach monitoring a status of an object device to produce a status signal and responding to a base station on the basis of the status signal when the base station calls the mobile station. Further, the Admitted Prior Art only teaches a picture terminal that can be connected to a mobile station to display a picture thereon (page 1, lines 1-19, as cited by the Examiner). Thus, the combination of references by the Examiner fails to teach or suggest the elements of the present invention, as required by 35 U.S.C. §103(a).

The Examiner has not cited any references that would render the communication system and method provided in claims 1-48 obvious. Therefore, Applicant respectfully submits that the Examiner has not met his burden of establishing a prima facie case of obviousness based on the prior art under 35 U.S.C. §103(a). Accordingly, Applicant respectfully requests withdrawal of

the 35 U.S.C. §103(a) rejection of claims 1-5, 7, 19-21, 25-27, 30-31, 38, 40-43, 45-46 and 48, and respectfully request allowance of claims 1-48.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Aasheesh V. Shravah
Registration No. 54,445

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

AVS:jam